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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/447,226	11/22/1999	JACK HENKIN	6356.US.P3	3545

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EXAMINER

LUKTON, DAVID

ART UNIT	PAPER NUMBER
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1653

DATE MAILED: 01/14/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/447,226

Applicant(s)

Henkin

Examiner

David Lukton

Art Unit

1653



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE one MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on Oct 31, 2001

2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) 1-17 is/are pending in the application.

4a) Of the above, claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☐ Claim(s) _____ is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☒ Claims 1-17 are subject to restriction and/or election requirements.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) ☐ All b) ☐ Some* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. _____.

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

15) ☐ Notice of References Cited (PTO-892)

18) ☐ Interview Summary (PTO-413) Paper No(s). _____

16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

19) ☐ Notice of Informal Patent Application (PTO-152)

17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____

20) ☐ Other: _____

Applicants' election of Group I without traverse is acknowledged, as is the elected specie.

However, due to a change in examiners, the restriction is modified, as set forth below.

*

This application contains sequence disclosures that are encompassed by the definitions for amino acid sequences set forth in 37 CFR 1.821. However, this application fails to comply with the requirements of 37 CFR 1.821 through 1.825 with regard to the sequence disclosures.

See, for example, the sequence on page 64, line 1; page 63, line 1; and page 62 line 14.

Applicant is given the time period set in this letter within which to comply with the sequence rules, 37 CFR 1.821-1.825. Failure to comply with these requirements will result in ABANDONMENT of the application under 37 CFR 1.821(g). Extensions of time may be obtained by filing a petition accompanied by the extension fee under the provisions of 37 CFR 1.136. In no case may an applicant extend the period for response beyond the six month statutory period.

*

Restriction to one of the following inventions is required under 35 U.S.C. §121:

1. Claims 1-14 and 16, limited to peptides in which "A₀" is not hydrogen.
2. Claims 1, 2, 5, 6, 14, 16 limited to peptides in which all of the following conditions are met: (a) "A₀" is hydrogen, (b) A₄ is an L-amino acid, and (c) A₄ is one of the first five amino acids recited on page 196, line 68+.
3. Claims 1-6, 8, 9, 11, 14, 16 limited to peptides in which "A₀" is hydrogen, and simultaneously A₄ is a D-amino acid.

4. Claim 15, drawn to a method of treating a disease using the compounds of Group 1.
5. Claim 15, drawn to a method of treating a disease using the compounds of Group 2.
6. Claim 15, drawn to a method of treating a disease using the compounds of Group 3.
7. Claim 17, drawn to a method of isolating a receptor using the compounds of Group 1.
8. Claim 17, drawn to a method of isolating a receptor using the compounds of Group 2.
9. Claim 17, drawn to a method of isolating a receptor using the compounds of Group 3.

Claims 12 and 13 are not grouped. In the event that applicants elect one of Groups 1-3, claims 12 and 13 will be joined therewith.

The claimed inventions are distinct.

Claim 1 has been "trisected". Group 2 is drawn to peptides that consist exclusively of naturally occurring amino acids. Neither of Groups 1 or 3 is limited to such. However, in the event that applicants elect Group 2, and claims therein are found allowable, the possibility of rejoining either (or perhaps both) of Groups 1 and 3 will be considered, but subject to the introduction of any limitations that may have been introduced into the Group 2 claims.

Inventions 1-3 and 4-9 are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product

(MPEP 806.05(h)). Nevertheless, in the event that any of Groups 1-3 is elected, and claims therein found allowable, the corresponding method-of-use claims will be rejoined for further examination provided that the limitations present in the claims (drawn to compounds) are incorporated into the method claims [*In re Ochiai* (37 USPQ2d 1127)].

Applicant is advised that for the response to this requirement to be complete, an election of the invention to be examined must be indicated, even if the requirement is traversed (37 C.F.R. 1.143).

Applicant is reminded that upon cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently filed petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(h).

. . . .

In addition to the foregoing, applicants are required under 35 U.S.C. §121 to elect a disclosed specie for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. A "specie" is a specific compound, with all substituent variables fully accounted for. Applicants may simply re-affirm the previously elected specie, as long as it is encompassed by the elected group. In the event that applicants elect one of Groups 4-6, a second species election is required, namely a specific disease to be treated.

Applicant is advised that a response to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a generic claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP 809.02(a).

Should applicant traverse on the ground that the species are not patentable distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. §103 of the other invention.

Serial No. 09/447,226
Art Unit 1653

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Lukton. Phone: (703) 308-3213.

An inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

A handwritten signature in black ink, appearing to read "D. Lukton".

DAVID LUKTON
PATENT EXAMINER
GROUP 1800